

REMARKS

In accordance with the foregoing, new claims 14-26 are presented. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended and new claims are respectfully requested.

Claims 1-26 are pending and under consideration.

PAGES 3-5: REJECTION OF CLAIMS 1-13 UNDER 35 U.S.C. §103(a) OVER NGUYEN (U.S.P. 5,931,917)

The Examiner rejects claims 1-13 under 35 U.S.C. §103(a) as obvious over Nguyen. (Action at pages 3-5).

According to aspects of the present invention, a user specifies businesses to which they show their cart contents. The specified businesses provide additional information e.g., advertisements based on the cart's contents, to the user's cart. The user can then compare the additional information provided and select a product to meet their preferences. With such features, businesses by knowing a user's interests can advertise accordingly, thus increasing sales effectiveness. According to aspects of the present invention, when providing additional information, a business can automatically see what other businesses are advertising, and therefore, devise a more effective marketing strategy by providing a distinguishing advertisement.

***Prima Facie* Obviousness Not Established**

Features Not Described By Cited Art

Examiner's Contentions Not Supported

As provided in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F. 2d 1981, (CCPA 1974)."

Independent claim 1 recites an online sales promotion method including "receiving product information on said product and designation information on a third party being able to supply additional information about said product from a first user; associating said product information and designation information with cart identification information; notifying said third party of said cart identification information and product information; receiving said additional information from said third party; associating said additional information with said cart identification information; and notifying said first user of said product information, designation information and additional information associated by said cart identification information."

The Action concedes that Nguyen does not teach the features of independent claim 1. (Action at page 3).

Nevertheless, the Examiner rejects claims 1 contending merely that Nguyen "suggests same." (Action at page 4). The Examiner further contends that it is obvious that Nguyen:

. . . would have been selected in accordance with showing "an on-line incentive offering program . . . an incentive module, programmed to automatically activate incentive offers in response to data received from said shopping cart module... because such selection would have provided means where *"control passes. . . to the WWW server ... for the transaction to be appropriately formatted and the appropriate interface page presented, whether the transaction is a store front ... shopping cart . . . pay page ... standard terminal administration . . . transaction, or an extended terminal transaction.... "*

(Action at page 4).

The Examiner has given no support to the line of reasoning leading to such a conclusion. Further, Applicants submit that the Examiner's contentions, even if *arguendo* are correct, do not teach even some of the features recited in the claims, let alone all of the features. According to aspects of the invention, a user sends information about a product in their cart to a third party and the third party sends additional information to the user. Nguyen merely teaches a method for a secure communication of data in internet shopping for product payment. (See, for example Nguyen, col. 4. lines 40-60).

Such contentions are rejected by the USPTO as not satisfying the standards of *prima facie* obviousness necessary to support a rejection. (See, Memorandum of Stephen G. Kunin dated February 21, 2002 based on *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ 2d 1930 (1999), attached).

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and independent claim 1 (and claims dependent thereon) allowed.

***Prima Facie* Obviousness Not Established**

Features Not Described By Cited Art And Examiner's Contentions Not Supported

Independent claim 11 recites an online sales promotion apparatus used in a system to purchase a product over a network including "means for receiving product information on said product and designation information on a third party being able to supply additional information about said product from a first user . . . ; and means for notifying said first user of said product information, designation information and additional information associated by said cart identification information."

Independent claim 12 recites a computer-readable recording medium whereon is recorded an online sales promotion program, the program executing "receiving product information on said product and designation information on a third party being able to supply additional information about said product from a first user; . . . (and) . . . notifying said first user of said product information, designation information and additional information associated by said cart identification information."

Independent claim 13 recites an online sales promotion method including "prompting a user to select a desired product and vendor from which said user intends to purchase said product . . . ; and distributing said advertisement information to said user."

The Examiner rejects claims 11, 12, and 13 "for substantially the same reasons as independent claim 1." (Action at page 5).

As Applicants respectfully submitted above, the Examiner has given no support to the line of reasoning leading to such a conclusion. Further, Applicants submit that the Examiner's contentions, even if *arguendo* are correct, do not teach even some of the features recited in the claims, let alone all of the features. Such contentions are rejected by the USPTO as not satisfying the standards of *prima facie* obviousness necessary to support a rejection. (See, USPTO memo attached).

Conclusion

Since *prima facie* obviousness is not established, the rejection should be withdrawn and independent claims 11-13 allowed.

Taking Of Official Notice Unsupported

The Action also concedes that Nguyen does not teach the features of dependent claims 2-10. (Action at page 2). Nevertheless, the Examiner rejects claims 2-10 contending that "Official Notice is taken that both the concepts and the advantages of the elements of claims 2-10 were notoriously well known."

As set forth in MPEP §2144.03 entitled Taking of Official Notice Is Unsupported:

. . . not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts . . . must always be supported by citation to some reference work recognized as standard in the pertinent art. In re Ahlert, 424 F.2d at 1091, 165 USPQ at 420-21.

Applicants request the Examiner support the taking of Official Notice or withdraw the rejection.

Conclusion

Since the taking of Official Notice is not supported, the rejection should be withdrawn the claims 2-10 allowed.

NEW CLAIMS

New claims 14-20 recite an online sales promotion method including "receiving via a network a designation of one or more information-providing terminals and a designation of a product from a first user terminal;(and) storing in a first storage, in association with a cart identifier, product information and information on a designated information-providing terminal and the first user terminal that has designated the information-providing terminal."

New claim 21 recites an online sales promotion device including " an acceptance means for receiving, via a network, designation of one or more information-providing terminals and designation of a product from a first user terminal; (and) a first storage means for storing, in association with a cart identifier, product information, information on designated information-providing terminals and a first user terminal that has designated the information-providing terminals."

New claim 22 recites a computer-readable recording medium storing a program to perform online sales promotion, by receiving via a network, designation of one or more information-providing terminals, and designation of a product from a first user terminal; (and) storing, by a first storage, in association with a cart identifier, product information of a product, information regarding designated information-providing terminals and the first user terminal that has designated the information-providing terminals." ;

New claims 23-26 recite an online sales promotion method including associating product information and designation information of a third party that can supply additional product information with cart identification information of a first user."

These, and other, features of claims 14-26 patentably distinguish over the cited art, and they are submitted to be allowable for the recitations therein.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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